No. 06-693

Supreme Court, U.S.
FILED
DEC 18 2006
OFFICE OF THE CLERK

In The Supreme Court of the United States

FALKO-GUNTER FALKNER, GEORG HOLZER and FRIEDRICH DORNER,

Petitioners,

v.

STEPHEN C. INGLIS, *et al.*,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Robert G. McMorrow, Jr.
Counsel of Record
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
Wilmington, Delaware 19899
(302) 658-9141

Counsel for Respondents

THE LEX GROUP^{DC} ♦ 1750 K Street N.W. ♦ Suite 475 ♦ Washington, DC 20006
(202) 955-0001 ♦ (800) 815-3791 ♦ Fax (202) 955-0022 ♦ www.thelexgroupdc.com

QUESTION PRESENTED

Whether the Petition presents any question appropriate for grant of certiorari where the alleged errors relate to disputed factual issues on which Respondent prevailed in the proceedings below?

STATEMENT OF PARTIES AND CORPORATE INTEREST

The parties who appeared in the proceeding below are Falko-Gunter Falkner, Georg Holzer and Friedrich Dorner ("Petitioner") and Stephen C. Inglis, Michael E.G. Boursnell, and Anthony C. Minson ("Respondent").

The real party in interest for Stephen C. Inglis et al. (Respondent) is Xenova Research Limited, formerly Cantab Pharmaceuticals Research Ltd. All parent companies and publicly held companies which own 10% or more of the stock of the real party in interest are: Xenova Group Ltd.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

STATEMENT OF PARTIES AND CORPORATE INTEREST ii

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES v

SUMMARY OF THE ARGUMENT 1

ARGUMENT 2

1. This Case is Unconnected to a Dispute within the Federal Circuit, and the Petition Presents no other Compelling Reasons for Grant of Certiorari 2

2. The Content of Inglis' Patent Applications is Incorrectly Characterized Throughout the Petition 5

3. The Decision Finding Enablement of the Inglis Priority Applications was Based on Application of the Correct Legal Standard of Enablement and was Amply Supported by the Evidence of Record 6

4. The Decision Finding Written Description Support in the Inglis Priority Applications and Involved Application was Based on Correct Application of the Law of Written Description and was Amply Supported by the Evidence of Record.....11

CONCLUSION AND STATEMENT OF RELIEF SOUGHT 18

TABLE OF AUTHORITIES

Page(s)

CASES

In re Wands,
858 F.2d 731 (Fed. Cir. 1988) 7, 8

Kewanee Oil Co. v. Bicron Corp.,
416 U.S. 470 (1974) 13

Pfaff v. Wells Elecs.,
525 U.S. 55, 119 S. Ct. 304,
142 L. Ed. 2d 261 (1998) 14, 15

Spectra-Physics, Inc. v. Coherent, Inc.,
827 F.3d 1524 (Fed. Cir. 1987) 8

University of Rochester v.
G.D. Searle and Company,
375 F.3d 1303 (Fed. Cir. 2004),
cert. denied, 543 U.S. 1015,
125 S. Ct. 629 (2004) 4, 14

Vas-Cath, Inc. v. Mahurkar,
935 F.2d 1555 (Fed. Cir. 1991) 12

Webster Loom Co. v. Higgins,
105 U.S. (15 Otto.) 580 (1881) 8

STATUTE

35 U.S.C. § 112 ..... 1, 11, 13, 14

35 U.S.C. § 119 12

35 U.S.C. § 120 12

OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

SUMMARY OF THE ARGUMENT

The Petition explains no connection between a conflict among the judges of the Court of Appeals for the Federal Circuit ("Federal Circuit") and the facts of the present case. Petitioner suggests an intra-Federal Circuit controversy concerning whether the "written description" requirement of 35 U.S.C. § 112 is separate from the "enablement" requirement of 35 U.S.C. § 112. The Federal Circuit's opinion in this case, however, does not indicate any relation between this case and such a controversy. The Federal Circuit's analysis addressed enablement *and* written description, applying a correct legal analysis to both issues.

Identifying no legal error, Petitioner reargues factual matters to allege that Inglis' disclosure is not sufficient to satisfy the enablement and written description requirements. These arguments raise no compelling issues for certiorari, however, since the sufficiency of a party's patent application disclosure, for purposes of both written description and enablement, is based on factual determinations. The disputed factual issues were resolved against Petitioner based on the evidence presented at the agency level, before the Board of Patent Appeals and Interferences at the U.S. Patent and Trademark Office ("Board").

As explained in this Opposition, Petitioner's arguments asserting the insufficiency of Inglis'

disclosures are contrary to the weight of evidence developed in the record. Petitioner is dissatisfied with the Board's factual findings, and with the weighing of the evidence in this case, but the Board's factual findings are fully supported by the record and were found to be free of error by the Federal Circuit.

For these reasons, the Petition presents no compelling issues for review and the request for a writ of certiorari should be denied.

ARGUMENT

1. This Case is Unconnected to a Dispute within the Federal Circuit, and the Petition Presents no other Compelling Reasons for Grant of Certiorari

On pages 5 of the Petition, it is asserted that certiorari should be granted since a conflict exists among some of the judges of the Federal Circuit which "concerns whether there exists a separate written description requirement in the patent laws ... beyond enabling an invention ..." See also pp. 17 and 19 of the Petition. In response, Respondent disagrees that the indicated conflict has any relevance to this case. The opinion of the Federal Circuit panel addressed the sufficiency of the Inglis disclosures from the standpoint of *both* enablement (App. 14a-15a) and written description (App. 15a–

21a).[1] The Federal Circuit opinion contains no discussion of whether the written description requirement is separate from the enablement requirement. Indeed, Petitioner never raised any argument based on the separateness of those requirements before either the Board or the Federal Circuit.[2]

There was no dissent from the Federal Circuit panel opinion. App. 1a-21a. Moreover, Petitioner raised the same objections which are raised in the Petition in a "Combined Petition for Rehearing and Petition for Rehearing En Banc by Appellant Falkner" filed with the Federal Circuit on June 26, 2006. The Federal Circuit summarily denied all aspects of the relief requested in that Petition, with no written opinion and no judges dissenting from the denial of *en banc* review, by Order of August 24, 2006. It is reasonable to conclude that the Federal

---

[1] Respondent uses the same abbreviations to refer to the Appendix to the Petition ("App. __a") and the Joint Appendix ("A __") record used by Petitioner. See footnote 6 on page 7 of the Petition.

[2] Page 2 of the Petition asserts conflict within the Federal Circuit on the basis of "two competing ideologies" but does not clearly spell out what those two alleged competing ideologies are. Petitioner suggests that the "ideology" which prevailed in this case requires only the "thinnest" disclosure. The competing ideology is not specified. Nor is it explained how these "competing ideologies" – whatever they are - have any relation to whether the enablement and written description requirements are separate. The Petition argument as a whole, therefore, does not clearly articulate the alleged "conflict" within the Federal Circuit, nor how this case is related to the alleged conflict.

Circuit saw none of the significance or urgency to this case which is asserted in the Petition.

The dissents from other Federal Circuit decisions, cited on pages 2, 17-18 and 20 of the Petition, have no demonstrated relevance to the facts of this case.[3] One of the dissents cited on page 18 of the Petition is by Judge Gajarsa, yet, Judge Gajarsa authored the Federal Circuit opinion in this case, further illustrating the absence of a connection between this case and any intra-Federal Circuit dispute.

In place of any compelling legal issue, the Petition presents reargument of the same allegations made below against the sufficiency of Inglis' disclosures.[4] As explained herein, these contentions deal with disputed factual issues. These arguments have been rejected by the Board (based on the contested evidentiary record and Petitioner's failure to prove its allegations) and rejected by the Federal Circuit (based on finding substantial evidence support for the Board's factual findings). Moreover,

---

[3] On pages 20-21 of the Petition, Petitioner cites the dissent from the denial of *en banc* review by the Federal Circuit in *University of Rochester v. G.D. Searle and Company*, 375 F.3d 1303 (Fed. Cir. 2004). The citation provided by Petitioner is not complete since it omits an indication that certiorari was denied in that case, at 543 U.S. 1015, 125 S. Ct. 629 (2004).

[4] The "Inglis disclosures" refers to the Inglis priority applications (which Falkner challenged before the Board on both written description and enablement grounds) and the Inglis '040 application involved in the interference (which Falkner challenged before the Board only on written description grounds).

the decision reached below is based on a correct application of the law relating to written description and enablement. There was no misapplication of law requiring correction by this Court.

2. The Content of Inglis' Patent Applications is Incorrectly Characterized Throughout the Petition

The Petition describes the Inglis patent applications as containing only a two-sentence disclosure relevant to poxvirus embodiments. See, e.g. Petition at page 6, lines 3-6; page 7, 2d full paragraph; page 13, lines 19 and 27; page 14, lines 2 and 16-20; page 22, lines 2-3; page 30, lines 7-13. In response, this characterization of Inglis' disclosures is incorrect. The Inglis applications describe the subject invention broadly as being applicable to vaccines based on different viruses. The invention is then exemplified more specifically by reference to herpesvirus and poxvirus embodiments. As the Federal Circuit explained, the Inglis applications contain generic (general) disclosure, followed by detailed working examples which exemplify the invention by reference to herpesvirus embodiments, and three passages (not two sentences) which describe that the invention includes poxvirus embodiments. App. 11a-15a. Petitioner's suggestion that the "generic" disclosure and herpesvirus exemplification is irrelevant to practicing poxvirus embodiments is contrary to the factual findings made below. For example, the Board found that Inglis' disclosure for identifying an essential viral gene was "extensive" (App. 48a) and specifically

found that the herpesvirus embodiment working examples provided by Inglis would render making a poxvirus embodiment "more facile" (App. 50a).

3. The Decision Finding Enablement of the Inglis Priority Applications was Based on Application of the Correct Legal Standard of Enablement and was Amply Supported by the Evidence of Record

The Petition argument focuses on the allegedly insufficient *quantity* of disclosure directed specifically to poxvirus embodiments of Inglis' invention. As discussed above, the Petition has not accurately described the quantity of disclosure provided in Inglis' priority applications. Both the Board and the Federal Circuit were cognizant of the quantity of the disclosure contained in the Inglis applications, since both the Board and the Federal Circuit summarized the content of those applications in their respective opinions. App. 48a (Board opinion); App. 12a-14a (Federal Circuit opinion).

Both the Board and the Federal Circuit cited to the doctrine that patent disclosures are drafted to be read by a person skilled in the relevant art. The parties in this case stipulated to a very high level of ordinary skill in the art. App. 47a (Board opinion); App. 14a (Federal Circuit opinion); A 624 (stipulation). The Board found this high level of skill to be accurately reflected by the "voluminous prior art and reference material cited in the record." App. 48a.

Based on the evidence produced by the parties on the enablement issue, the Board found that: "*Falkner has not proved* that the routineer could not have practiced the subject matter of the [interference] count based on this disclosure and what was known and understood by the routineer in this art without 'undue' experimentation." App. 48a, last 5 lines (emphasis added). It can be seen that what Petitioner is asserting as legal error by the Board is, at bottom, a failure by Petitioner to prove its allegations.[5]

The Federal Circuit pointed out that enablement is a conclusion of law based on underlying findings of fact. App. 15a.[6] Upon reviewing the Board's decision finding enablement, and presented with the same set of arguments which Petitioner presents here, the Federal Circuit found that the Board had not erred. App. 15a.

---

[5] Petitioner's "Question Presented" (Petition, first page) makes the unjustified and argumentative assumption that Inglis did not disclose the poxvirus embodiments of the invention or how to make and use them. The assumption built into the "Question Presented" in the Petition is itself contrary to the evidence of record.

[6] The factual inquiries which underlie a conclusion of enablement (whether or not the required amount of experimentation would be "undue" to a person of ordinary skill in the art) are set out in *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988), which was cited by the Board at App. 41a and applied throughout its opinion. The Federal Circuit cited these factors at App. 10a. Petitioner presents no contention that *In re Wands* is not controlling law on how enablement should be assessed.

The Federal Circuit cited and applied the familiar patent law doctrine that a patent disclosure need not teach, and preferably omits, descriptive matter which is known to those skilled in the art, citing *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.3d 1524 (Fed. Cir. 1987). App. 15a. Petitioner does not openly challenge the validity of that doctrine, which traces back to at least as early as this Court's decision in *Webster Loom Co. v. Higgins*, 105 U.S. (15 Otto.) 580 (1881)(explaining that a patent disclosure is written for a skilled artisan, and subject matter which is common and well-known need not be included). A fundamental issue which Petitioner has overlooked throughout this case is that a patent disclosure is read, not in a vacuum, but in light of what the skilled reader already knows. As pointed out by the Board, Petitioner's motions in this case erroneously focused upon what the Inglis priority applications *do not* disclose, instead of explaining how what *is* disclosed would have been understood by a skilled artisan. App. 47a. Petitioner's motions were also deficient for failing to separately address the existing state of the art as of the filing date of each of the Inglis priority applications, which were filed over a period of five years App. 31a-32a.[7]

---

[7] Petitioner argues at pp. 25-27 that permitting reliance on what is already known in the art allows for *nunc pro tunc* inventions. Following Petitioner's argument to its logical conclusion, a patent drafter could never rely on what is already known in the literature, but instead would need to draft every patent specification with the detail of a production blueprint. Petitioner's argument is contrary to long-standing patent law doctrine as expressed in *Spectra-Physics*, *Webster Loom* and *In re Wands* that patent disclosures are directed towards a reader skilled in the art.

Both the Board and the Federal Circuit found, based on the evidence of record, that the experimental details asserted by Petitioner to be missing from Inglis' disclosure (such as identifying poxvirus "essential" genes from existing maps of the poxvirus genome) were readily known from the literature. A worker skilled in this art – what the Board referred to as a "routineer" - is presumptively familiar with the published literature.[8] The Board also made a factual finding that complex laboratory techniques are ordinary in the field of vaccine preparation. App. 49a.

One of Petitioner's primary arguments to the Board and to the Federal Circuit – and again in the Petition (pages 26-27) - is that the herpesvirus exemplification provided in the working examples of the Inglis priority applications would not have enabled one skilled in the art to make a poxvirus embodiment, since herpesviruses and poxviruses are very different viruses. It was also argued that Inglis had admitted, in another context during *ex parte* prosecution of its patent application, that herpesviruses and poxviruses are different (Petition, pages 7 and 13). Respondent countered these arguments before the Board with testimony and supporting evidence that a person skilled in the art, as of the relevant dates, was familiar with the differences between herpesviruses and poxviruses, and that the herpesvirus working examples provided

---

[8] The presumption of familiarity with published art on the part of the hypothetical person of "ordinary skill in the art" applies normally, and was made express in this case by the parties' stipulation as to the applicable level of ordinary skill in the art A 624-625.

by Inglis could be adapted by the skilled worker to make a poxvirus embodiment. This was a contested factual issue which was the subject of conflicting expert testimony and other evidence before the Board.[9] The Board found, and the Federal Circuit specifically upheld the finding, that the differences between herpesviruses and poxviruses were well-known to the skilled worker as of the relevant dates. App. 50a; App. 14a. The Federal Circuit cited to this evidence and agreed with the Board's finding that the differences would have "*aided*" the person of skill in the art to make a poxvirus embodiment. App. 14a. Petitioner's argument disregards the fact-finding made below, and is asking this Court to reach the exact opposite conclusion on this contested factual issue.

As to Inglis' alleged "admission" about the differences between poxviruses and herpesviruses, Inglis explained to the Federal Circuit that: i) the statements being cited as "admissions" were not relevant to the issues presented in the motions before the Board; and ii) the argument was belatedly raised before the Board. The Federal Circuit declined to address this allegation, suggesting that Petitioner's argument lacked merit.

For these reasons, the Petition has made no showing that the Board or the Federal Circuit committed any reversible error of law or fact when

---

[9] Respondent's expert testimony was from Dr. Michael Boursnell. A 783-815. Petitioner presented the expert testimony of Dr. Miles Carroll. A 163-244. The Board discounted the testimony of Dr. Carroll as being conclusory on the enablement issue. App. 50a-51a.

finding Inglis' priority applications to be enabling for the subject matter of the interference count. The Petition offers no compelling reason to grant a writ of certiorari as it relates to the enablement requirement of 35 U.S.C. § 112. There was no misapplication of the law of enablement.

4. The Decision Finding Written Description Support in the Inglis Priority Applications and Involved Application was Based on Correct Application of the Law of Written Description and was Amply Supported by the Evidence of Record

The findings below about which Petitioner complains are attributable to the inadequacy of Petitioner's evidence and presentation before the Board, not to legal error.

As explained by the Board, Petitioner's expert witness, Dr. Carroll, applied a legally incorrect standard of "actual possession" in the testimony he offered to the Board on the issue of written description. Dr. Carroll also incorrectly focused on how to "make and use" the invention (which concerns enablement) in his testimony alleging lack of written description. For these reasons, the Board was correct to discount the probative value of Dr.

Carroll's testimony on the issue of written description. App. 37a; App. 39a–40a.[10]

Petitioner had the burden of proof by a preponderance of evidence to prove the alleged lack of written description support for the interference count in Inglis' priority applications.[11] While Petitioner's motions alleging lack of written description were *prima facie* deficient to meet its burden due to the defectiveness of the supporting evidence and the improper legal analysis, both the Board and the Federal Circuit went on to carefully review the entire record and to consider and address the various arguments challenging Inglis' written description support for the subject matter of the interference count and for its claims in the interference.

Sufficiency of written description is a question of fact. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991), cited at App. 10a. The

---

[10] As explained by the Board, Petitioner's motions attacking Inglis' priority applications also misconstrued and misapplied the law as it relates to obtaining benefit of an earlier application for purposes of priority, which is different from obtaining benefit of an earlier application for purposes of 35 U.S.C. § 119 or 35 U.S.C. § 120. App. 28a-29a.

[11] On appeal to the Federal Circuit, Petitioner alleged various grounds of procedural error on the part of the Patent and Trademark Office in its designation of Inglis as the "senior" party. This designation placed the burden of proof (by a preponderance of evidence) upon Petitioner to contest Inglis' right to rely on the filing dates of its priority applications. The Federal Circuit responded to Petitionser's assertions of procedural error by stating simply: "These arguments lack merit, and we shall not further discuss them." App. 10a.

Federal Circuit cited to declaration testimony from Inglis' expert witness, Dr. Boursnell, as support for the Board's factual findings on written description. App. 16a. The Federal Circuit also cited to decisional law that the content of a disclosure, not its length, is what is relevant to the adequacy of a written description. App. 16a.

The Petition argues that *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) is controlling precedent overlooked by the Federal Circuit. The *Kewanee Oil* decision concerned the relationship between federal patent law and state trade secret law, and cites to the then-existing statutory language concerning the disclosure needed to support a patent. 416 U.S. 480-481. The Petition fails to explain how the subsequent Federal Circuit decisions relied upon by the Board and by the Federal Circuit in this case are inconsistent with the currently-existing statutory language of 35 U.S.C. § 112.

While the language of 35 U.S.C. § 112 requires the terms of a disclosure to be "full" and "clear" and "concise" and "exact," a body of decisional law has evolved which sets out the factual considerations for determining whether those statutory requirements are met *in a particular case*. Bypassing any discussion of the decisional law cited by the Federal Circuit, the Petition at page 25 makes a conclusory and unwarranted assertion that the Federal Circuit ignored the applicable constitutional and statutory requirements.

More specifically as to written description, the Petition fails to allege legal error in the Federal Circuit's specific holdings that neither "examples" nor "an actual reduction to practice" nor "recitation of known structure" (viral gene sequences already known in the literature) were required to satisfy the written description requirement of 35 U.S.C. § 112 on the facts of this case. App. 16a, last paragraph. In fact, the Federal Circuit was on solid ground as to each of these points.

The Federal Circuit first explained that the absence of examples does not itself render written description of an invention inadequate. App. 17a. The Petition cites no contrary decisional law for the proposition that written description support under 35 U.S.C. § 112 *does* require examples.

The Federal Circuit next explained that an "actual reduction to practice is not required" for written description support, citing *University of Rochester, supra* and *Pfaff v. Wells Elecs.*, 525 U.S. 55, 66, 119 S. Ct. 304, 142 L. Ed. 2d 261 (1998). App. 17a-19a. Petitioner concedes that "current patent law" recognizes that a reduction to practice may be either actual or constructive (Petition, page 15, footnote 16), and the Petition cites no contrary decisional law for the proposition that written description support under 35 U.S.C. § 112

necessarily requires an actual reduction to practice.[12] The Petition makes no effort to distinguish this Court's statement in *Pfaff*, cited by the Federal Circuit, that an invention can be "complete" in the absence of an actual reduction to practice. App. 19a.[13]

---

[12] Petitioner criticizes Inglis' disclosure as not being "real research" (Petition, page 25). While Inglis's disclosure does not evidence an actual reduction to practice of a poxvirus embodiment, the disclosure provides "working" examples ("real research") illustrating the herpesvirus embodiment, which the Board found to provide guidance to the skilled artisan to make and use the invention including poxvirus embodiments. In addition, Respondent notes that Petitioner's patent in the interference contains Examples 1-4 (written in the present tense) and Example 5 (written in the past tense, reporting work actually done). A 116-119. Examples 1-4 are prophetic examples, and not "real research." Petitioner's priority application filed April 29, 1994 (mentioned at page 9 of the Petition) contained Examples 1-4 but not Example 5. Nonetheless, Petitioner consistently maintained its right to rely upon the filing date of the April 29, 1994 application as a date of invention in the interference. Thus, Petitioner was, like Inglis, relying upon a "constructive" reduction to practice of poxvirus embodiments in its earliest-filed patent application as the basis for priority support for the interference count. Indeed, the Petition states on page 10 that Petitioner's April 29, 1994 application "disclosed the modified poxvirus vaccine invention." On this record, Petitioner is not in a favorable position to insist that only "real research" – an actual reduction to practice - can suffice to provide an adequate written description of an invention.

[13] Petitioner continues even now to incorrectly urge an "actual" reduction to practice standard for written description, by arguing that the Inglis applications contain "no evidence that they [Inglis et al.] ever figured out how to ***actually make*** a modified poxvirus vaccine." Petition, page 23 (emphasis added). As explained by the Board, by the Federal Circuit, and by this Court in *Pfaff*, that is not the correct standard.

Lastly, the Federal Circuit explained that description of poxvirus gene sequences already known in the scientific literature was not required to support Inglis' written description. As noted above, the parties stipulated in this case that the person of ordinary skill in the vaccine art would have been familiar with the relevant poxvirus literature. The Federal Circuit pointed to Dr. Bournell's testimony and associated evidence and stated: " 'the skilled person would have been readily able to choose an essential vaccinia [poxvirus] gene' based on references that have been publicly available since 1990. The testimony of Falkner's expert, Dr. Carroll, did not refute this claim." App. 16a. In view of Dr. Boursnell's testimony, and the absence of contrary testimony, it cannot be reasonably argued that this finding lacks substantial evidence support. In connection with written description, the Federal Circuit explained that requiring disclosure of known genetic sequences would add to the bulk, but not to the quality, of patent specifications. App. 20a-21a. The Petition cites no authority that requires the recitation of known genetic sequences to satisfy the written description requirement, nor provides any policy reasons for why such a requirement should be imposed.

On pages 6, 11-13 and 22, the Petition asserts that an inconsistency exists in the Board's findings that the Inglis PCT application supports the count, but at the same time, does not anticipate claim 1 of Petitioner's patent. In response, there is no inconsistency. The interference count was defined in

the alternative as Falkner claim 1 or Inglis claim 29. See A70. Inglis claim 1 defines a vaccine comprising a poxvirus having a mutated (inactivated) essential gene. Falkner claim 29 differs from Inglis claim 1 by further reciting that the mutant poxvirus comprises a gene encoding an antigen under control of a promoter. This distinction was fully appreciated by the Board. See A77 (p. 20, ll. 16-21). The Board's opinion denying Inglis' motion asserting anticipation of Falkner claim 1 clearly indicates that the Board premised its denial on a finding that the evidence cited by Inglis had not been shown to describe a heterogene encoding an antigen "under the transcriptional control of a promoter," as recited in Falkner's claim 1. App. 62a-63a. While the Board found that Inglis had not explained how this element of Falkner's claims was present in the proffered prior art reference so as to find "anticipation" of Falkner's claims (App. 63a), that same element is not recited in the portion of the count defined by Inglis claim 29. Accordingly, Inglis was able to show support for the interference count in the earlier Inglis disclosure, while being found not to have met its burden to prove that the same disclosure contained all elements of Falkner's claim 1. Page 7 of the Petition mischaracterizes the Board's holding by stating that the Inglis' application did not disclose "modified poxvirus vaccine." What the Board found was that

Inglis had not met its burden to prove anticipation of Falkner's claims. App. 63a.[14]

The absence of inconsistency between these holdings was explained to the Federal Circuit in response to this same argument (both on original briefing and on Petitioner's request for *en banc* review) and the Federal Circuit deemed this argument to be unworthy of discussion. It is a meritless argument.

CONCLUSION AND STATEMENT OF RELIEF SOUGHT

Petitioner's arguments are contrary to the factual findings made in the proceedings below, which are fully supported by the evidence presented to the Board. Petitioner has identified no misapplication of law to those facts by the Board or by the Federal Circuit. Accordingly, Petitioner has raised no compelling reason for grant of a writ of certiorari, and it is requested that the Petition be denied, allowing the interference judgment in favor of Respondent to stand.

---

[14] The Board's wording makes clear that, in the Board's view, Inglis had not carried its burden on the motion alleging anticipation of Falkner claim 1. That is different from holding that the prior art was, in fact, non-anticipatory. Inglis did not cross-appeal that decision for the reason that Inglis prevailed on priority of invention, thereby invalidating all of Falkner's patent claims on the basis of priority of invention. Whether Falkner's claims were invalid for other reasons (such as anticipation by published prior art) had become a moot issue.

Respectfully Submitted,

Robert G. McMorrow, Jr.
Connolly Bove Lodge & Hutz LLP
1007 North Orange Street
Wilmington, DE 19899
(302) 658-9141
Counsel for Respondents